

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gredley, Sarah
Serial No.: 10/521,139
Filing Date: 12 January 2005
For: Picture Frame

RECEIVED

9 NOV 2006

Legal Staff
International Division

RENEWED PETITION UNDER 37 CFR § 1.137(b)

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
Post Office Box 1450
Alexandria, Virginia 22313-1450

Attention: Office of PCT Legal Administration

Sir:

Applicant respectfully submits with this cover letter a renewed petition requesting reconsideration of her petition under 37 C.F.R. § 1.137(b) to revive PCT application PCT/GB03/02228 for priority benefit for the above-captioned continuation application.

A petition to revive was filed on January 12, 2005. A fresh copy of the petition papers was filed on August 5, 2005 at the request of the Office. The petition was dismissed in a Decision on Petition mailed on January 4, 2006. A first renewed petition was filed on March 6, 2006 with additional information, including a Declaration by the Applicant. The petition was again dismissed in a Decision on Petition mailed on August 9, 2006.

This second renewed petition is being filed within three months from the mailing date of the Decision on Petition, with a petition for a one-month extension of time being filed herewith. As instructed in the Decision on Petition, this renewed petition is being sent to the mailing address: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The accompanying renewed petition requesting reconsideration of the petition under 37 C.F.R. § 1.137(b) to revive PCT application PCT/GB03/02228 includes additional information further supporting a finding that the entire delay in filing the above-captioned application was unintentional.

Also submitted herewith is a Preliminary Amendment and Request for Priority Benefit.

Also submitted herewith, as suggested in the August 9, 2006 Decision on Petition, is a petition for the acceptance of an unintentionally delayed claim for priority under 37 CFR 1.78(a)(3), along with the requisite fee. That petition is presented as a conditional petition; Applicant requests that it be taken up only upon granting of the accompanying Renewed Petition under 37 CFR 1.137(b) to revive the PCT application.

In view of this filing to amplify and clarify the original petition, Applicant submits that she has complied with the provisions of 37 CFR § 1.137(b) and respectfully requests revival of PCT application PCT/GB03/02228 for priority benefit for the above-captioned continuation application.

The Decision on Petition states that no additional petition fee is required for this request for reconsideration. A petition is filed herewith for a one-month extension of the time to file this renewed petition. A Fee Transmittal is filed herewith to cover the cost of that Petition for Extension of Time. A telephone call is requested if any additional fee is required.

Respectfully submitted,

Dated: 08 November 2006



Peter D. McDermott (Reg. No. 29,411)
Banner & Witcoff, Ltd.
28 State Street, 28th Floor
Boston, MA 02109-1775
Tel: (617) 720-9600
Fax: (617) 720-9601
E-Mail: pmcdermott@bannerwitcoff.com

Enclosures:

- 1) Request for Reconsideration - Renewed Petition Under 37 CFR § 1.137(b) to Revive an Unintentionally Abandoned Application
- 2) Declaration
- 3) Further Preliminary Amendment and Request for Priority Benefit
- 4) Petition (Conditional) Under 37 C.F.R. § 1.78(a)(3) To Accept Late Claim of Priority
- 5) Petition for Extension of Time
- 6) Fee Transmittal

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: GREDLEY, Sarah

Appln No: 10/521,139

Filed: January 12 2005

For: PICTURE FRAME

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
Post Office Box 1450
Alexandria, Virginia 22313-1450
Attention: Office of PCT Legal Administration

DECLARATION

I, Yvonne Catherine Johnson, of the firm Barker Brettell, hereby declare:

1. That the communication to the applicant, Sarah Gredley, dated 1 October 2004 from Barker Brettell regarding national phase filings corresponding to PCT/GB03/02228 also contained other attorney-client privileged content. Attached hereto is a selectively redacted copy of the communication to Ms. Gredley. The redacted content is not relevant to the clarity of the instructions provided regarding the timing requirements of a US national phase filing corresponding to the PCT application.
2. That despite the content of the 1 October 2004 communication to Ms. Gredley regarding the timing requirements of national phase filings corresponding to the PCT application, in a telephone conversation with Ms. Gredley on 17 November 2004, Ms. Gredley still seemed unclear about the legal and final nature of the national phase deadline, as compared to, for example, nominal deadlines by which Barker Brettell requested information or payment from her. The relevance of the 23 November 2004 deadline was subsequently explained again to Ms. Gredley. In this regard, however, the

explanation unavoidably involved some of the complexities and nuances inherent in the PCT system, including that the 23 November 2004 deadline did not apply to all countries, for example that a later deadline of 23 December 2004 applied for a European (EPC) application, and that extension or grace provisions existed for some countries, for example for a European (EPC) application where action could still validly be taken at least two months after the deadline on payment of a surcharge. Further, Ms. Gredley was burdened with the knowledge that various PCT deadlines for her application had been allowed to pass without taking any action and without adverse consequence, including the deadline for filing Article 19 PCT amendments and the deadline for filing a Demand for International Preliminary Examination.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made in the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment or both, under 18 USC 1001, and that such wilful false statements may jeopardise the validity of the application or any patent issued thereon.

Signed

Date ...8 November 2006

Yvonne Catherine JOHNSON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gredley, Sarah
Serial No.: 10/521,139
Filing Date: 12 January 2005
For: Picture Frame

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
Post Office Box 1450
Alexandria, Virginia 22313-1450

Attention: Office of PCT Legal Administration

Sir:

RECEIVED

9 NOV 2006

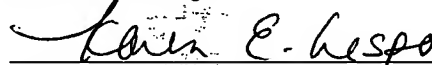
Legal Staff
International DivisionCERTIFICATE OF EXPRESS MAIL"Express Mail" Label No. EV 814488948 USDate of Deposit: November 8, 2006

I hereby state that the following:

- 1) Renewed Petition Under 37 CFR § 1.137(b) (3 pp.);
- 2) Request for Reconsideration - Renewed Petition Under 37 CFR § 1.137(b) to Revive an Unintentionally Abandoned Application with Attachment A, Declaration (11 pp.);
- 3) Further Preliminary Amendment and Request for Priority Benefit (3 pp.);
- 4) Petition (Conditional) Under 37 C.F.R. § 1.78(a)(3) to Accept Late Claim of Priority (3 pp.)
- 5) Petition for Extension of Time (one month) (1 pg.);
- 6) Fee Transmittal (1 pg., in duplicate); and
- 7) Return Receipt Postcard.

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above and is addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450.

Karen E. Crespo



Signature of person mailing paper or fee
BANNER & WITCOFF, LTD

28 State Street, 28th Floor
Boston, MA 02109
Telephone: (617) 720-9600
Facsimile: (617) 720-9601

Certificate of Express Mail
U.S. Application No. 10/521,139
Page 1 of 1

I look forward to hearing from you shortly regarding the countries in which you wish to proceed and to receiving appropriate up-front payments in this regard. Further, in the event that you do indeed wish to proceed with a European Patent Application, please indicate whether you would like to go ahead with all available designation states or whether there are any specific ones you would like to designate, and also whether you would like to cover any of the available extension states.

Yours sincerely,

Yvonne C. Johnson
on behalf of Ms Lucy P. Trueman

SH

Ms. S. Gredley
Nespereira
Casa Nova da Cruz C/D 5541
Sao. Teotonio
Odemira
Portugal

Your ref.

Our ref.
LPT0482/YCJ

Please reply to Birmingham
01 October 2004

Dear Sarah

International Patent Application No. PCT/GB2003/002228
Entitled: "Picture Frame"

I refer to our telephone conversation on 30 September 2004 regarding how to proceed with your above-mentioned International Patent Application.

As discussed, we are now approaching the stage where it is necessary to convert your International Patent Application into national or regional Patent Applications in the countries of interest to you. The deadline for taking action in this regard in most countries is 23 November 2004.

I understand that you would be interested in proceeding in at least the USA and Europe and can confirm that converting your International Patent Application into an application in the USA would cost in the region of £3,000 to £3,500 whilst filing an application that covers the majority of European countries using the European Patent Convention system would also cost in the region of £3,000 to £3,500.

Under the centralised patent system of the European Patent Convention (EPC) we would file a single application that would cover various European countries for you. Then at the point that this application granted the Patent would effectively split up into a bundle of national Patents in the countries required. The countries that you would be able to designate in a European Patent Convention Application are: Austria, Belgium, Bulgaria, Switzerland and Liechtenstein, Cyprus, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, the UK, Greece, Hungary, Ireland, Italy, Luxembourg, Monaco, Netherlands, Portugal, Romania, Sweden, Slovenia, Slovakia and Turkey.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gredley, Sarah
Serial No.: 10/521,139
Filing Date: 12 January 2005
For: Picture Frame

RECEIVED

9 NOV 2006

Legal Staff
International Division

REQUEST FOR RECONSIDERATION

**RENEWED PETITION UNDER 37 CFR § 1.137(b)
TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION**

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
Post Office Box 1450
Alexandria, Virginia 22313-1450

Attention: Office of PCT Legal Administration

Sir:

Applicant respectfully requests reconsideration of her previously filed petition under 37 C.F.R. § 1.137(b) to revive PCT application PCT/GB03/02228 (the "PCT application"). Applicant seeks co-pendency with the above captioned application in order to secure priority benefit of the PCT application. The PCT application was unintentionally abandoned on November 23, 2004 and the present continuation application was filed on 12 January 2005.

Request For Reconsideration

Renewed Petition Under 37 CFR § 1.137(b) to Revive
an Unintentionally Abandoned Application

This petition to revive was filed on January 12, 2005, concurrent with the filing of the continuation application. A fresh copy of the petition papers was filed on August 5, 2005 at the request of the Office. The petition was dismissed in a Decision on Petition mailed on January 4, 2006. A first request for reconsideration and renewed petition was filed on March 6, 2006 with additional information, including a Declaration by the Applicant. The petition was again dismissed in a Decision on Petition mailed on August 9, 2006. This second request for reconsideration and renewed petition to revive is being filed within three months from the mailing date of the August 9, 2006 Decision on Petition, with petition for a one-month extension of time being filed herewith.

This second request for reconsideration and renewed petition is supported by all of the papers filed to date in this application, including a Declaration of the Applicant-inventor, Sarah Gredley, included as Attachment A to the first request for reconsideration and renewed petition.

In addition, as suggested in the August 9, 2006 Decision on Petition, Applicant includes with this second request for reconsideration and renewed petition, a copy of the instructions provided to her by Barker Brettell regarding national phase filings corresponding to the PCT application. As discussed telephonically with Attorney-Advisor Anthony Smith of the Office of PCT Legal Administration, the Barker Brettell communication providing instructions to the Applicant regarding national phase filings has attorney-client privileged content, and so is selectively redacted to properly protect

Request For Reconsideration

Renewed Petition Under 37 CFR § 1.137(b) to Revive
an Unintentionally Abandoned Application

the interests of the Applicant. A Declaration is filed herewith by the Barker Brettell firm, that the redacted content is not relevant to the clarity of the instructions provided regarding the timing requirements of a US national phase filing corresponding to the PCT application.

It can be seen from the instructions provided regarding the timing requirements of a US national phase filing corresponding to the PCT application, that an individual such as the Applicant, a neophyte in patent matters unfamiliar with the complex and varying patent rules and regulations in Europe and the US, could easily have misapprehended –as she did– the US national phase filing deadline requirements for a PCT application.

In addition, as also suggested in the August 9, 2006 Decision on Petition, Applicant includes with this second request for reconsideration and renewed petition, a further preliminary amendment to restate the claim for priority benefit added to the first page of the specification by prior preliminary amendment.

In addition, as also suggested in the August 9, 2006 Decision on Petition, Applicant includes with this second request for reconsideration and renewed petition, a petition under 37 CFR 1.78(a)(3) for the acceptance of an unintentionally delayed claim for priority. Such petition has been made conditionally. That is, the petition for the acceptance of an unintentionally delayed claim for priority will be needed and useful only upon the Office granting Applicant's renewed petition to revive the PCT application. Accordingly, the accompanying petition for the acceptance of an

Request For Reconsideration

Renewed Petition Under 37 CFR § 1.137(b) to Revive
an Unintentionally Abandoned Application

unintentionally delayed claim for priority is made conditional on the Office granting Applicant's renewed petition to revive the PCT application.

The Applicant, Sarah Gredley, earnestly requests that this request for reconsideration and renewed petition to revive the unintentionally abandoned PCT application be granted. She acted very promptly after the unintentional abandonment was realized.

The key facts in this matter, established by earlier filed papers in connection with this petition, show that revival is appropriate. At the time of needing to provide instructions for filing national phase applications, Ms. Gredley had moved her residence and business overseas to Portugal and was understandably finding the transition stressful. Moving a business and residence to a new location, especially moving to a new country with a different language and culture, is disorienting and can cause confusion and disruption in even the most organized households and businesses.

This was the first patent application that Ms. Gredley had ever filed. She was not familiar with the differing rules of the multiple different patent systems involved. It is only reasonable to recognize that patent application proceedings, especially international application proceedings, are highly complex and can be bewildering for those, such as Ms. Gredley, not routinely immersed in the numerous rules, regulations, statutes and practices of the patent world.

Under these stressful circumstances, and against the backdrop of a prolonged PCT proceeding in which various dates could be extended or safely ignored,

Request For Reconsideration

Renewed Petition Under 37 CFR § 1.137(b) to Revive
an Unintentionally Abandoned Application

Ms. Gredley failed to appreciate the deadline for filing a US national phase application corresponding to the PCT application. Ms. Gredley says in her Declaration that she failed to appreciate that the national phase deadline for filing a US filing was non-extendable, and certainly it is understandable that a neophyte such as Ms. Gredley could make that mistake.

In fact, in Ms. Gredley's PCT application both the deadline for filing Article 19 PCT amendments following the International Search Report and the deadline for filing a Demand for International Preliminary Examination were allowed to pass without taking any action, which may have led to confusion for Ms. Gredley regarding the nature of PCT national phase deadlines. She had also previously been informed of the fact that the deadlines for entry into the PCT national phase were 23 January 2004 for some countries (e.g. Brazil, Norway, Singapore - which at that time had not adapted their law to reflect the PCT law change that gave national phase deadlines of 30 months under Chapter I as well as Chapter II), but that this deadline would be extended to 23 November 2004 if a Demand for International Preliminary Examination was filed by 23 December 2003. These complexities and nuances contribute to the explanation of Ms. Gredley's – and any non-patent attorney's - confusion regarding possible extension of the 23 November 2004 PCT national phase deadline.

In the end, the decision on this petition must be based on Ms. Gredley having indicated to her British counsel in a telephone conversation on 30 September 2004, that she intended to proceed with the US national phase of the PCT application, that she was interested in proceeding with patent protection for her picture frame invention in at

Request For Reconsideration


Renewed Petition Under 37 CFR § 1.137(b) to Revive
an Unintentionally Abandoned Application

least Europe and United States, and on Ms. Gredley's statement in her Declaration, that the failure to take the necessary action to file such application by the deadline was unintentional and due to a mistaken belief that the US national phase application could still be filed later. (Gredley Declaration, paragraph 10.)

In view of the above, Applicant submits that she has complied with the provisions of 37 CFR § 1.137(b) and respectfully requests revival of the above-captioned application, which was unintentionally abandoned on 27 November 2004.

Respectfully submitted,

Dated: 08 November 2006



Peter D. McDermott (Reg. No. 29,411)
Banner & Witcoff, Ltd.
28 State Street, 28th Floor
Boston, MA 02109-1775
Tel: (617) 720-9600
Fax: (617) 720-9601
E-Mail: pmcdermott@bannerwitcoff.com

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2006

Complete if Known

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$60.00

Application Number	10/521,139
Filing Date	January 12, 2005
First Named Inventor	Gredley, Sarah
Confirmation No.	Not Yet Assigned
Art Unit	Not Yet Assigned
Attorney Docket No.	006329.00005

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : _____

☒ Deposit Account Deposit Account Number: 19-0733 Deposit Account Name: Banner & Witcoff, LTD.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 30 (including Reissues)

Multiple dependent claims

	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 30 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ -20 or HP= _____ x _____ = _____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee(\$)** **Fee Paid (\$)**

_____ - 3 or HP= _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	_____

4. OTHER FEE(S)


Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Petition for Extension of Time (1 month) (1 pg.)

Fees Paid (\$)


\$60.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	29,411	Telephone	617-720-9600
Name (Print/Type)	Peter D. McDermott	Date	11/08/06		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2005 (fees effective on or after December 8, 2004)		Docket Number (Optional) 006329.00005
Application Number 10/521,139		Filed January 12, 2005
For PICTURE FRAME		
Art Unit		Attorney Advisor: Smith, Anthony
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.		
The requested third month extension and fee are as follows (check time period desired and enter the appropriate fee below):		
	<u>Fee</u>	<u>Small Entity Fee</u>
<input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$120	\$60 <u>\$60.00</u>
<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$450	\$225 \$_____
<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$1020	\$510 \$_____
<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$1590	\$795 \$_____
<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2160	\$1080 \$_____
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.		
<input type="checkbox"/> A check in the amount of the fee is enclosed.		
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.		
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.		
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>19-0733</u> . I have enclosed a duplicate copy of this sheet.		
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.		
I am the <input type="checkbox"/> applicant/inventor.		
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71		
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).		
<input checked="" type="checkbox"/> attorney or agent of record. Registration Number <u>29,411</u>		
<input type="checkbox"/> attorney or agent under 37 CFR 1.34.		
Registration number reflecting under 37 CFR 1.34. _____		
 Signature	November 8, 2006 Date	
Peter D. McDermott Typed or printed name	(617) 720-9600 Telephone Number	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.		
<input checked="" type="checkbox"/> Total of <u>1</u> form is submitted.		

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.